

O I P E
JUL 25 2005 JC8
PATENT & TRADEMARK OFFICE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FEE
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL
(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/621,046
Filing Date	July 16, 2003
First Named Inventor	Constantine P. GRIGOROPOULOS
Art Unit	2813
Examiner Name	Chandra P. Chaudhari
Attorney Docket Number	UCB-6(B01-108)

Enclosed is a petition filed under 37 CFR 5.25 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees)

The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 13-3083:
 petition fee under 37 CFR 1.17(f), (g) or (h) any deficiency of fees and credit of any overpayments
Enclose a duplicative copy of this form for fee processing.
 Check in the amount of \$ 425.00 is enclosed. (\$200.00 Petition Fee and \$225.00 Extension Fee)
 Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

Signature

Peter L. Michaelson

Typed or printed name

July 20, 2005

Date

30,090

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: Constantine P. GRIGOROPOULOS, Nicole R. BIERI,
Dimos POULIKAKOS, Jaewon CHUNG

Atty. Doc. No.: UCB-6 (B01-108)

Serial No.: 10/621,046

Filed: July 16, 2003

Group Art Unit: 2813

Confirmation No.: 8907

Examiner: Chandra P. Chaudhari

Title: A METHOD FOR PRODUCING A STRUCTURE USING
NANOPARTICLES

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

07/27/2005 AKELLEY 00000016 10621046 SUPPLEMENTAL PETITION PURSUANT TO
01 FC:1463 35 U.S.C § 184 FOR
 200.00 RETROACTIVE FOREIGN FILING LICENSE

Petition

Applicants respectfully petition pursuant
to 35 U.S.C. § 184 that the foreign filing license granted
for the above application on November 25, 2003 be given
retroactive effect to January 9, 2001.

RECEIVED

JUL 26 2005

Supplemental Petition

OFFICE OF PETITIONS

On August 11, 2004 Applicants petitioned pursuant
to 35 U.S.C. § 184 for the retroactive granting of a
foreign filing license for the above US patent application.

Appl. No. 10/621,046
Supplemental Petition
Reply to Decision on Request of March 22, 2005

This petition was denied March 22, 2005 on the grounds that the requirements of 35 C.F.R. § 5.25(a)(3)(i, ii, iii) have not been met. A copy of the Decision on Request is attached.

The present Supplemental Petition includes the attached:

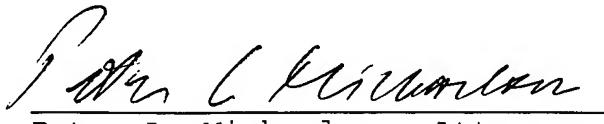
- a) Declaration from Constantine P. Grigoropoulos, the lead inventor, and
- b) Declaration from George Wolken, Jr., the lead attorney prosecuting the above-identified US patent application.

These declarations aver that: i) No secrecy order was or is in effect; ii) A foreign filing license was diligently sought following discovery of reasonable grounds for seeking one; and iii) An explanation of why the material was filed abroad without foreign filing license and without deceptive intent.

In light of the above, the attached Declarations, and the Petition and materials filed on August 11, 2004, applicants respectfully request that the foreign filing license granted on November 25, 2003 be given retroactive effect to January 9, 2001.

Respectfully submitted,

July 20, 2005



Peter L. Michaelson, Attorney
Customer No. 007265
Reg. No. 30,090
(732) 530-6671

Appl. No. 10/621,046
Supplemental Petition
Reply to Decision on Request of March 22, 2005

MICHAELSON & ASSOCIATES
Counselors at Law
Parkway 109 Office Center
328 Newman Springs Road
P.O. Box 8489
Red Bank, New Jersey 07701

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **July 21, 2005** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Peter L Michaelson
Signature

30,090
Reg. No.



✓ 5/21/05 - Ryz dw (GW)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/621,046	11-Aug-04	CONSTANTINE GRIGOROPOULOS, ET AL.	UCB-6 (B01-108)

Title: A METHOD FOR REPRODUCING A STRUTURE
USING NANOPARTICLES

--	--

Art Unit	Paper Number
----------	--------------

Correspondence Address:

PETER L. MICHAELSON
MICHAELSON & ASSOCIATES
PARKWAY 109 OFFICE CENTER
328 NEWMAN SPRINGS ROAD
P.O. BOX 8489
RED BANK, NEW JERSEY 07701

PATENT & TRADEMARK OFFICE
MAILED

MAR 22 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.

APR - 4 2005

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

In re: GRIGOROPOULOS, et al. :DECISION ON REQUEST
Petition Filing Date: August 11, 2004 :UNDER 37 CFR 5.25
Serial No.: 10/621,046
Docket No.: UCB-6 (B01-108)

Title: A METHOD FOR PRODUCING A STRUCTURE USING NANOPARTICLES

This is a decision on the petition filed August 11, 2004 for retroactive foreign filing license.

RECEIVED

Decision: Denied

JUL 26 2005

OFFICE OF PETITIONS

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

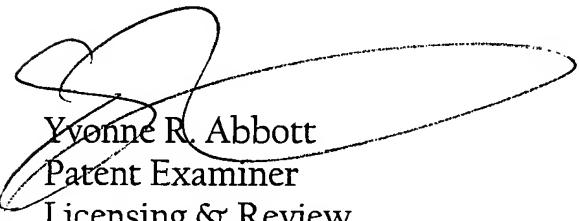
The petition is Denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(i, ii, iii) have not been met.

Although the Petition of Mr. Michaelson states the facts, background and basis for the Petition, there is no verified statement or declaration as to the nature of the error, or how and when it was discovered (thereby supporting a showing of diligence). The Petition merely states that a review of the facts indicates the possibility of an error occurred to invoke legal proceedings. In affect, it is not clear

from the Petition that the invention was made in the U.S. (i.e. that a foreign filing license is required) consequently invoking 35 U.S.C. 184 and 185. Petitioners must file a declaration(s) containing the pertinent information. Such a statement should include averments by those persons responsible for or having personal knowledge of the acts regarding filing in a foreign country (which may or may not be Mr. Michaelson, depending on his involvement in the foreign filing) and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

Thus, in the absence of a verified statement including an explanation or showing that the license was diligently sought, and that the foreign application was filed through error without deceptive intent, the provisions of 37 CFR 5.25 have not been met.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is DENIED, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Yvonne R. Abbott
Patent Examiner
Licensing & Review
(703) 308-2866

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: Constantine P. GRIGOROPOULOS, Nicole R. BIERI,
Dimos POULIKAKOS, Jaewon CHUNG

Atty. Doc. No.: UCB-6(B01-108)

Serial No.: 10/621,046

Filed: July 16, 2003

Group Art Unit: 2813

Confirmation No.: 8907

Examiner:

Title: A METHOD FOR PRODUCING A STRUCTURE USING
NANOPARTICLES

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS

**Declaration of Constantine P. Grigoropoulos
in Support of Petition for
Retroactive Foreign filing License**

I, the undersigned Constantine P. Grigoropoulos, hereby declare and affirm as follows:

1. I am the first named inventor for the above-identified US patent application. I am presently employed by the University of California, Berkeley ("UC-B") as Professor of Mechanical Engineering in the College of Engineering. I have held this position for the entire period of time described in this declaration. I have

personal knowledge of the facts and circumstances surrounding the invention described and claimed in the above-referenced patent application.

2. During the spring academic term of the year 2000 while on leave from UC-B, I conducted research at the Eidgenossische Technische Hochschule ("ETH") in Zurich, Switzerland.

3. This research at ETH resulted in a European patent application. I participated in the preparation and filing of this European patent application in cooperation with ETH and Swiss patent counsel retained by them. This European patent application was filed on or about January 10, 2001.

4. The subject matter of the European patent application was not under a secrecy order at the time it was filed in Europe, has not been made the subject of a secrecy order subsequent to that date, and is not now subject to a secrecy order.

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS

5. As of the date the European patent application was filed, I believed that the invention described and claimed therein resulted from research conducted by me and my collaborators at ETH, outside of the United States and, therefore, not subject to the foreign filing requirements of the US patent laws and regulations. This opinion was formed in good faith and based upon my personal knowledge of the subject matter of the European patent application in light of the research conducted by me and my

collaborators at ETH. Therefore, filing of the European patent application without a US foreign filing license was without deceptive intent.

6. After the filing of the European patent application, I and my co-inventors conducted further research on the subject matter of the invention, including research conducted in the United States. The above-referenced US patent application contains subject matter resulting from our work at ETH as well as from our work in the United States.

7. The subject matter of the above-referenced U.S. patent application was not under a secrecy order at the time it was filed and is not now under a secrecy order.

8. All statements made herein are made based upon information and belief, and are believed to be true, and that this declaration is made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of the application or any patent issuing thereon.

Subscribed this 14 Day of July, 2005.


Constantine P. Grigoropoulos



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: Constantine P. GRIGOROPOULOS, Nicole R. BIERI,
Dimos POULIKAKOS, Jaewon CHUNG

Atty. Doc. No.: UCB-6(B01-108)

Serial No.: 10/621,046

Filed: July 16, 2003

Group Art Unit: 2813

Confirmation No.: 8907

Examiner:

Title: **A METHOD FOR PRODUCING A STRUCTURE USING
NANOPARTICLES**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

Declaration of George Wolken, Jr.
in Support of Petition for
Retroactive Foreign filing License

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS

I, the undersigned George Wolken, Jr., hereby declare and affirm as follows:

1. I am a patent attorney registered to practice before the United States Patent and Trademark Office ("USPTO"), Reg. No. 30,441, and Of Counsel with the firm of Michaelson & Associates, USPTO Customer No. 007265. I have personal knowledge of the facts and circumstances surrounding the preparation, filing and prosecution of the above-identified application before the USPTO.

2. On or about June 13, 2003, the firm of Michaelson & Associates was retained by the Regents of the University of California on behalf of the University of California-Berkeley ("UC-B") to prosecute the above-identified patent application, and I was designated lead attorney to handle this matter. A US patent application was filed July 16, 2003 and received application serial number 10/621,046 (" '046"). A foreign filing license for this application was granted on November 23, 2003. No secrecy order has been imposed on the '046 application.

3. The '046 application was filed including subject matter from European Patent Application No. 01 100 537.8 ("EPA") as well as subject matter developed by the named inventors following the filing of the EPA. The EPA has previously been made of record in this case.

4. Based on information received during interviews with UC-B inventors, I concluded that the subject matter contained in the EPA was not invented in the US but derived from research activities occurring in Switzerland while UC-B researchers were temporary visitors at the Eidgenossische Technische Hochschule ("ETH") in Zurich, Switzerland. I also concluded from the same information that research activities conducted in the US contributed to subject matter contained in the '046 application.

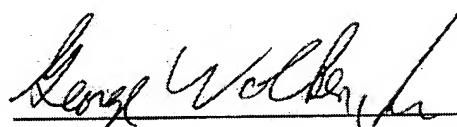
5. UC-B and ETH entered into an Inter-Institutional Agreement ("IIA") on July 6, 2004 related to the subject matter of the EPA and the '046 application. This IIA recites that research conducted both at ETH and at UC-B led to an "Invention" that is the subject matter of both the EPA and US patent applications. The first two pages of the IIA are attached hereto. I had no part in the negotiation or drafting

of the IIA and was not aware of its contents until after it had been executed by the parties.

6. I decided that the recitations in the IIA cast doubt on my conclusion that the subject matter of the EPA was invented outside the US. Rather than perpetuate such uncertainty, I concluded that seeking a retroactive foreign filing license pursuant to 35 U.S.C. § 184 was the proper course under statute and regulations. No secrecy order had been imposed and the subject matter had been granted a foreign filing license on November 23, 2003. The petition for a retroactive foreign filing license was diligently sought following the IIA and filed August 11, 2004.

7. All statements made herein are made based upon information and belief, and are believed to be true, and that this declaration is made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of the application or any patent issuing thereon.

Subscribed this 19th Day of July, 2005.



George Wolken, Jr.

Attachment: Inter-Institutional Agreement, pages 1 and 2.

UNIVERSITY OF CALIFORNIA, BERKELEY
OFFICE OF TECHNOLOGY LICENSING



**Inter-Institutional Agreement for
Producing a Structure Using Nanoparticles**

UC Case No: B01-108

ETH Zurich Reference: T-01-009

6 July 2004

This agreement is effective 6 July 2004 ("Effective Date") and is by and between, THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, a California Corporation, whose legal address is 1111 Franklin Street, 12th Floor, Oakland, California 94607-5200, acting through its Office of Technology Licensing, at the University of California, Berkeley, 2150 Shattuck Avenue, Suite 510, Berkeley, CA 94720-1620, ("REGENTS") and Eidgenossische Technische Hochschule Zurich, represented by Prof. Dr. Dimos Poulikakos, Institute of Energy Technology, whose legal address is ETH Zentrum ML J 36, Sonneggstrasse 3, CH-8092 Zurich, ("ETH Zurich").

BACKGROUND

Certain research conducted at the University of California (UC) by Prof. Constantine Grigoropoulos and Dr. Jaewon Chung was supported by an unrestricted gift fund administered by the University, and certain research conducted at ETH Zurich by Nicole Bieri and Dimos Poulikakos was supported by ETH Zurich.

RECEIVED

JUL 26 2005

OFFICE OF PETITIONS

The research resulted in the development of fabrication of structures using nanoparticles, described in UC Case No. B01-108, ETH Zurich Reference T-01-009 ("Invention"), invented by Prof. Constantine Grigoropoulos and Dr. Jaewon Chung of UC and Nicole Bieri and Dimos Poulikakos of ETH Zurich (collectively, "INVENTORS").

Prof. Constantine Grigoropoulos and Dr. Jaewon Chung have each agreed to assign their rights in the Invention to REGENTS, subject to REGENTS patent policy.

Nicole Bieri and Dimos Poulikakos have each agreed to assign their undivided patent rights in the Invention to ETH Zurich, subject to the patent policy of that institution.

ETH Zurich authorized the filing of a patent application with the European Patent Office, claiming the Invention, and such EPO application was filed on October 1, 2001.

UC authorized the filing of a utility patent application with the U.S. Patent and Trademark Office, claiming the Invention and including improvements made by the inventors since the filing of the EPO application, and such U.S. application was filed on July 16, 2003.

Concurrently with the US filing, ETH authorized filing in the EPO of a continuation also claiming the improvements.

It is the mutual desire of the parties that ETH Zurich will take responsibility for obtaining and maintaining patent protection in territories of the EPO, and UC will be responsible for obtaining and maintaining patent protection in the US.

It is further the desire of the parties that licensing and commercialization of the Invention be managed by REGENTS on behalf of both parties, subject to any overriding obligations of REGENTS and ETH Zurich to the sponsors of the research; and to that end ETH Zurich agrees not to grant to any person (other than REGENTS) any right, title, or interest in and to the Invention or the Patent Rights.

NOW, THEREFORE, for and in consideration of the mutual covenants and promises, REGENTS and ETH Zurich agree as follows.

1. DEFINITIONS

1.1 "Patent Rights" means all right, title and interest in and to the following:

- a) European Patent Application No. EP 1 223 615, filed October 1, 2001; and
- b) United States Patent Application Serial No. 10/621,046, filed July 16, 2003; and